



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF:

Funke et al.

Grp. Art. Unit: 3747

Application No: 10/732,723

Date: November 30, 2004

Filed: December 10, 2003

Examiner: J. H. Hoang

DIAGNOSTIC TEST FOR VARIABLE
VALVE MECHANISM

Atty Docket: 03-157

RESPONSE TO OFFICE ACTION

In response to the Office Action dated September 3, 2004, please consider the following remarks. Reconsideration of the present application is respectfully requested.

Claims 1-18 stand rejected under 35 USC §102(b) over Kumagai et al. Applicants respectfully disagree since Kumagai et al. flatly fails to disclose Applicants claimed inducement of a misfire via a variable valve mechanism. Although the term "misfire" is well known in the art, Applicants made it utterly clear in paragraph [15] that the term misfire means that a particular cylinder receives fuel in a particular engine cycle but fails to produce power in that cycle. Kumagai et al., on the other hand, teach detection of a misfire and then a strategy to determine whether the detected misfire can be attributed to a failure of the thing it calls a variable valve mechanism or simply due to a normal misfire. Kumagai et al. teaches that this is accomplished by stopping the fuel supply to the engine cylinder with the possibly faulty mechanism. Although Kumagai et al. does use the term "misfire" liberally, Applicants did not. In other words, when Kumagai et al. teaches cutting off fuel to the cylinder being tested, it inherently teaches prevention of the possibility of a misfire occurring in that cylinder. Applicants also take exception to Kumagai et al.'s naming of its cylinder disabler apparatus as a "variable valve mechanism". Thus, when Applicants' claims are read in a manner consistent with explicit definition contained in Applicants' specification, as they must be, there should be no

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dispute that Kumagai et al. teaches something entirely different from what Applicants have taught and claimed. Thus, because Applicants have explicitly defined the term "misfire", the Examiner is not permitted to abandon that definition in favor of Kumagai et al's. characterization of the term "misfire" as applying to a cylinder that is not even receiving fuel. The MPEP requires that a §102(b) rejection be supported by more than the coincidental use of similar wording in a cited reference; the MPEP requires that the reference actually teach what the applicant has claimed. In this case, Kumagai et al. clearly do not teach what Applicants have claimed. Thus, because the MPEP requires that a reference disclose exactly what an Applicant has claimed, and because in this case Kumagai et al. does not do this, Applicants respectfully request that all of the §102(b) rejections based upon Kumagai et al. be withdrawn.

This application is believed to be in condition for allowance of claims 1-18. However, the Examiner is invited to contact the undersigned attorney (812) 333-5355 if any additional minor clarification would put this application in even better condition for allowance.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'MB 3 2A', written in a cursive, stylized script.

Michael B. McNeil
Reg. No. 35,949